

**REMARKS**

The Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**I. Status of the Claims**

Claim 1 is amended to recite that in the composition, R<sup>1</sup> and R<sup>2</sup> independently indicate a hydrogen atom or a linear or branched fatty acid residue having 1 to 24 carbon atoms or a benzoic acid residue, provided that R<sup>1</sup> and R<sup>2</sup> are not both benzoic acid residues. Claim 5 is added to recite that a composition of claim 1 improves gloss of lips after application of the composition to the lips. Support for amendment to claim 1 is found for example on page 3, lines 14-16 of the Specification, and support for claim 5 is provided for example on page 3, lines 4-11 of the Specification. No new matter has been introduced, and claims 1-5 are currently pending to be examined on their merits.

**II. 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, Rejections**

Claims 1 and 2 are rejected under 35 U.S. C. § 112, second paragraph, as being indefinite. The Applicants respectfully disagree, and submit that the term “residue” such as “fatty acid residue” and “benzoic acid residue” is generally known in the art to refer to a portion of a larger molecule. For Example, the “benzoic acid residue” means a radical of benzoic acid from which a hydroxide group is removed. Similarly, the “fatty acid residue” means a radical of fatty acid from which a hydroxide group is removed. The Applicants respectfully request reconsideration of the rejections.

**III. 35 U.S.C. § 103 Rejections**

Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being obvious over Mitsumatsu (WO 02/19977 A1), and claim 4 is rejected over Mitsumatsu, in view of Healy (WO 00/26285). The Office alleges that it would be obvious for one of ordinary skill in the art to optimize the amount of the pentaerythritol ester oil of Mitsumatsu to provide a composition having desired

pentaerythritol ester oil content. The Office further alleges that it would be obvious to combine the compounds of Mitsumatsu and the pentaerythritol compounds of Healy to make lipsticks and hair care compositions to reach the claimed compositions. The Applicants respectfully disagree.

A. Current Obviousness Standard

The Supreme Court recently reaffirmed the Graham factors for determining obviousness in *KSR Int'l Co. v. Teleflex Inc.* (No. 04-1350) (U.S., April 30, 2007). The Graham factors, as outlined by the Supreme Court in *Graham et al. v. John Deere Co. of Kansas City et al.*, 383 U.S. 1 (1966), are: 1) determining the scope and contents of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; 3) resolving the level of ordinary skill in the pertinent art; and 4) evaluating evidence of secondary consideration. The Supreme Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a), and held that the proper inquiry for determining obviousness is whether the improvement is more than the predictable use of prior art elements according to their established functions. The Court noted that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed, and specifically stated:

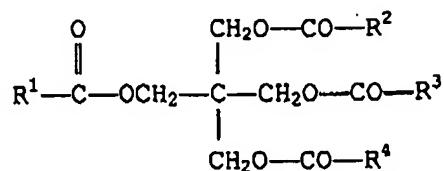
Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was *an apparent reason to combine the known elements in the fashion claimed* by the patent at issue. To facilitate review, this analysis should be made explicit.

*KSR Int'l Co. v. Teleflex Inc.*, slip op. at 14 (emphasis added). As discussed below, the cited art cannot render the claimed invention obvious.

B. Mitsumatsu and Healy

1. The instant Application Is Not Obvious Over Mitsumatsu

Mitsumatsu discloses a hair care composition that is heated before being application thereof, the composition comprising a pentaerythritol ester oil having the formula:

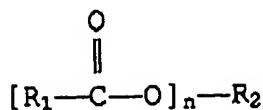


which is similar to those of the compounds used in Examples 1 and 2 and Comparative Example 1 (see Table I on page 7 of the Specification). Nevertheless, as disclosed on page 2, lines 5-19 of the Specification, merely having pentaerythritol ester derived oil ingredients is insufficient to achieve desirable properties. For example, as shown in Example 1 and Comparative Example 1 in Tables I and II in the Specification, among the many ester oils, only those in the claimed compositions (e.g., tribenzoic acid-mono-2-ethylhexanoic acid pentaerythritol ester – see Example 1) create products with unexpected desired results, namely applicability, stickiness, gloss on lips, moisture feeling and cosmetic durability. By contrast, the use of tetra-2-ethylhexanoic acid pentaerythritol ester creates products with poor results, as shown in Table I and II. This difference is based upon the fact that the pentaerythritol ester must have two or more benzoic acid residues, as claimed in claim 1 of the instant application. This property is neither disclosed nor suggested by Mitsumatsu.

Further, Mitsumatsu teaches away from the instant application by disclosing that the composition of Mitsumatsu is heated with a heating device to a temperature from about 30°C to 60°C. It is generally known in the art that within this temperature range, many cosmetics, such as lipsticks as claimed in the instant application, cannot be used with desirable results.

## 2. The instant Application Is Not Obvious Over Healy

The Office alleges that Healy discloses a gel composition comprising an ester compound having the formula:



wherein  $\text{R}_1$  is independently a phenol or hydrocarbyl,  $\text{R}_2$  is a hydrocarbyl, and  $n$  is 4, which is a structural homolog of the present compound (i.e., different only by  $\text{CH}_2$  group). Without acquiescing to the grounds of rejections, claim 1 has been amended to recite that  $\text{R}^1$  and  $\text{R}^2$  are not both benzoic acid residues in the formula (I). Healy does not suggest or disclose this property.

The Applicants further emphasize that to achieve desirable results, having pentaerythritol ester oil is not sufficient; rather, it is surprisingly important to have the compositions as claimed in the instant application. To further illustrate this unexpected property, the Applicants respectfully submit Table 1, where results from additional Experiments A and B to those already shown in Table I in the Specification are provided. Experiments A and B were conducted in the same manner as disclosed in the Specification, except that Experiment A and B employ different amounts of dibenzoic acid 2-ethylhexanoic acid behenic acid pentaerythritol ester, which  $\text{R}^1$  is a 2-ethylhexanoic acid residue and  $\text{R}^2$  is a behenic acid residue in the formula (I). Taking all of the results as a whole, it can be seen that the results are highly dependent on the compositions, and thus it would not have been obvious for one of ordinary skill in the art to reach the same desired results as claimed in the instant application by using the compound of Healy.

### 3. No Motivation to Combine Mitsumatsu and Healy

Because Mitsumatsu teaches away, and Healy does not suggest the property as recited in the instant application, one of ordinary skill in the art would not have been motivated to combine Mitsumatsu with Healy. See *KSR Int'l Co.* Additionally, even if one attempts to combine Mitsumatsu and Healy, because Mitsumatsu requires the composition to be heated to a temperature that is highly undesirable for cosmetic applications such as lipsticks, the high temperature would have rendered the products resulting from a combination of Mitsumatsu's and

Healy's teachings undesirable. Therefore, the claimed compositions are not obvious over Mitsumatsu or Healy, or a combination thereof. The Applicants thus respectfully request that obviousness rejections be withdrawn.

Finally, to provide an exemplary demonstration of the unexpected desirable results from the claimed compositions, the Applicants respectfully submit that the cosmetic compositions according to the claimed compositions have been widely commercialized successfully in Japan and around the world, particularly because of the superior improvements in the gloss, moisture feelings, and cosmetic durability. The total sales to date are about 15 billion yen (over US \$13 million).

CONCLUSION

The Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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TABLE 1

	Ex.1	Ex.2	Comp. Ex.1	Comp. Ex.2	Exp. A	Exp. B
Tribenzoic acid -mono-2-ethylhexanoic acid pentaerythritol ester	30	50	-	-	-	-
Tetra-2-ethylhexanoic acid pentaerythritol ester	-	-	30	-	-	-
2-Ethylhexanoic acid - methoxycinamic acid pentaerythritol ester	-	-	-	30	-	-
Dibenzoic acid 2 -ethylhexanoic acid behenic acid pentaerythritol ester	-	-	-	-	30	50
Squalane	5	5	5	5	5	5
Methylphenyl polysiloxane 20 cs	5	5	5	5	5	5
Diisostearyl malate	10	10	10	10	10	10
Glyceryl diiso stearate	10	-	10	10	10	10
Glyceryl tri-2-ethylhexanoate	10	-	10	10	10	10
Trimethyl pentaphenyl trisiloxane	10	10	10	10	10	10
Ceresin wax	11	11	11	11	11	11
Microcrystalline wax	2	2	2	2	2	2
Silicone-coated red pigment	4	4	4	4	4	4
Bengara-coated titanated mica	3	3	3	3	3	3
Fragrance	q.s.	q.s.	q.s.	q.s.	q.s.	q.s.
(Total)	(100)	(100)	(100)	(100)	(100)	(100)
Ease of application	B	B	B	B	B	B
Stickiness	B	B	B	B	B	B
Gloss on lips	B	A	D	C	B	A
Moisture feeling	B	A	C	C	B	A
Cosmetic durability	B	A	C	C	A	A+